

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Levy

Art Unit: 2624

Application No: 10/774,312

Confirmation No.: 5422

Filed: February 5, 2004

VIA ELECTRONIC FILING

For: WATERMARKING SYSTEMS AND
METHODS

Examiner: K. Fujita

Date: August 4, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the final rejection of claims 1-5, and 8 in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

Date: August 4, 2008

Respectfully submitted,
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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Board will reverse the rejections.

Claim 1 (and claims dependent thereon) employ “step plus function” language, as authorized by § 112, ¶ 6. However, the Final Action failed to present the *Donaldson* analysis required for such claims (*In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed Cir, 1994); *see also: Examination Guidelines For Claims Reciting A Means or Step Plus Function Limitation In Accordance With 35 U.S.C. 112, 6th Paragraph*, 1162 O.G. 59 (May 17, 1994).).

Appellants submit that the prior art teachings of Hayashi are not § 112 ¶ 6 equivalents of the acts detailed in Appellants’ specification that correspond to the claimed steps. However, until the Office makes a *prima facie* showing under *Donaldson*, there is no burden on Appellants to further respond.

Because the Office has not properly analyzed the claims, the Board will reverse.

Moreover, while Hayashi may be said to relate to the general field set forth in the *preamble* of claim 1 (*i.e.*, embedding a collection of feature that can be used to facilitate computation of geometric distortion (rotation) of the object after encoding), he does not concern the subsequent requirement of the claim: making this collection of features “resistant to attack.”)

Again, the Board will recognize the Office’s error and reverse.

(The foregoing is sufficient to establish that the rejections would not be sustained on appeal. Accordingly, Appellants do not belabor this paper with additional remarks on the rejections, the art, or the claims – all of which are reserved for possible later presentation.)